

## **REMARKS**

Claims 22-34, 36-38, 54-59, 78-86, 93-122, 124, 126, 128, and 130-149 are pending in the Application. Claims 22-34, 36-38, 54-59, 78-86, 93-95, 122, 124, 126, 128, and 134-149 stand rejected, and claims 96-121 and 130-133 stand withdrawn, in the Office action mailed February 15, 2011. Claims 22 and 30 are amended by this response. Claims 22, 30, 54, and 78 are independent claims. Claims 23-29, 122, and 134-137, claims 31-34, 36-38, 124, and 138-141, claims 55-59, 93-95, 126, and 142-145, and claims 79-86, 128, and 146-149 depend, respectively, from independent claims 22, 30, 54, and 78. Applicants respectfully request reconsideration of the pending claims, in light of the remarks set forth below.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is **essential** that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. § 2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth “all reasons and bases” for rejecting the claims.

### **Amendments to the Specification**

The status of applications listed in the section titled "CROSS REFERENCE TO RELATED APPLICATIONS" has been updated. Applicants respectfully submit that these amendments do not add new matter.

### **Amendments to the Claims**

Claims 22 and 30 have been amended as shown above to address the concerns of the Office, and to correct antecedent basis issues. Support for the amendments to claims 22 and 30 may be found, for example, at FIG. 55a and at page 259, line 15 to page 263, line 10 of the Specification. Applicants respectfully submit that the amendments to claims 22 and 30 do not add new matter.

### **Objections to Claims**

The claims were objected to as not being in accordance with 37 C.F.R. 1.126. Applicants express appreciation to the Examiner for noting that the text of claim 31 was inadvertently omitted from the Listing of Claims. The then-amended text of claim 31 appeared in Applicants' response to the Office action of November 18, 2009, which was filed March 10, 2010, and was inadvertently omitted in the response to the Office action of March 30, 2010, which was filed June 30, 2010. Applicants have restored the text of claim 31 as it should appear if the oversight had not occurred. Applicants respectfully submit that claim 31 was never cancelled by the Applicants, and was merely omitted due to an editing error, and is now simply being restored to its original place in the Listing of Claims. Therefore, Applicants respectfully submit that because claim 31 was never cancelled, and is not a new claim, a new claim number is not required. Further, Applicants respectfully submit that restoring the text of claim 31 to the Listing of Claims in a manner consistent with the text that appeared in the response filed March 10, 2010 does not add new matter.

### **Rejections of Claims**

Claims 22-30, 32-38, 54-59, 78-86, 93-95, 122, 124, 126, 128, and 134-149 stand rejected under 35 U.S.C. §112, first paragraph. Claims 22-30, 32-38, 122, 124,

and 134-141 stand rejected under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse the rejection.

Applicants respectfully note that the Office has not asserted rejections of any claims over prior art under any subsection of either 35 U.S.C. §102 or 35 U.S.C. §103.

**I. Claims 22-30, 32-38, 54-59, 78-86, 93-95, 122, 124, 126, 128, And 134-149 Are In Compliance With 35 U.S.C. §112, First Paragraph**

Claims 22-30, 32-38, 54-59, 78-86, 93-95, 122, 124, 126, 128, and 134-149 stand rejected under 35 U.S.C. §112, first paragraph. Applicants respectfully traverse the rejection.

**With regard to independent claims 22, 30, and 54**, the Office rejects claims 22, 30, and 54 by asserting, in part, at page 3, the following:

The limitation "identifying a second remote system accessible to the portable terminal device" in claim 22 line 14, and similarly in claim 30 line 13, 54 lines 5-6, and claim 54 line 6-7, was not described in the specification in such a way as to reasonably convey to one of ordinary skill in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Page 294 lines 3-13 of the specification describes a call request packet (*i.e.*, a request for information). The call request packet contains an internal call routing field for storing the lowest cost routing pathway (along with its cost) which does not use an outgoing telephone line and an external call routing field for storing the lowest cost the lowest cost routing pathway (along with cost) utilizing an outgoing telephone line. However, the original disclosure fails to describe any fields of the call request packet or any request for information identifying a second remote system accessible to a portable terminal device. Thus, the limitation constitutes new matter.

Applicants respectfully submit that the Office is simply misinterpreting the language of claim 22. The relevant portion of claim 22 states the following:

wherein the portable terminal device transmits to a first remote system a request for information identifying a

second remote system accessible to the portable terminal device via the wireless packet network and operable to, at least, convert between digital voice packets of the portable terminal device and voice signals compatible with a public telephone network;

It appears that the Office is misinterpreting the underlined portion of claim 22 as “a request for information[, the request] identifying a second remote system...,” rather than its intended and clear meaning as written of “a request for information identifying a second remote system...” Applicants respectfully submit that the analysis by the Office of the “fields” of Applicants’ disclosed “call request packet,” and the statement by the Office that “the original disclosure fails to describe any fields of the call request packet or any request for information identifying a second remote system accessible to a portable terminal device,” suggests that the Office is simply misinterpreting the language of claim 22. (emphasis added) Applicants respectfully submit that Applicants’ disclosure discloses the claimed subject matter, as written, as will be demonstrated, below.

Applicants respectfully submit that the Specification supports Applicants’ claim 22 feature “a request for information identifying a second remote system accessible to the portable terminal device via the wireless packet network,” at least at FIG. 55a and page 259, line 15 to page 261, line 12, which states, in part, the following:

Conversion between forms along a communication path between, for example, the mobile terminal 5523 and the telephone 5563 does take place, however. Specifically, the mobile terminal 5523 transmits a call route request packet which includes the identity of the destination device, the telephone 5563. Upon receiving the route request packet, the access device, consulting its routing table, concludes that it does not have a telephone line pathway (or any other pathway) to the telephone 5563. Thus, the access device 5513 sends the request toward the root access device 5505, i.e., to the access device 5509. Upon receipt, the access device 5509 consults its routing table, discovers that it has access to the telephone line 5541 and records the availability of the telephone line 5541 in the route request packet. Thereafter, the access device 5509 transmits the route request packet toward (and to) the root access device 5505.

Upon receiving the packet, the root device 5505 consults its routing table yet identifies no lower cost telephone line access than that provided by the access device 5509 as was previously recorded in the route request packet. Therefore, the root access device 5505 converts the route request packet into a reply packet and forwards it back to the terminal 5523 via the access devices 5509 and 5513.

Upon receipt of the reply packet, the terminal 5523 offers to the user and/or software of the terminal 5523 the telephone line routing pathways (in this case only one) identified in the reply packet. Upon selecting the offered pathway, the terminal 5523 sends a call setup packet to the access device 5513 which forwards the setup packet to the access device 5509. Upon receipt, the access device 5509 must determine from the setup packet whether the destination of the call expects a voice stream or voice packet transfer. If the setup packet indicates a destination identifier which is not the telephone number being dialed, the access device 5509 will use voice packet transfer. Alternatively, which is the case in this example, the setup packet indicates that the destination identifier is the telephone number being dialed, and the access device 5509 concludes that it must send a voice stream.

Thereafter, the access device 5509 interfaces between the mobile terminal 5523 and the telephone 5563.

Applicants respectfully submit that, as shown above, Applicants' disclosed "call route request packet" requests information identifying (*e.g.*, requests a "routing pathway") a second remote system (*e.g.*, "access device 5509") accessible to the portable terminal device (*e.g.* "mobile terminal 5523") via the wireless packet network (*see, e.g., id.* at page 255, lines 1-7) and operable to, at least, convert between digital voice packets of the portable terminal device and voice signals (*see, e.g., id.* at page 262, lines 3-5) compatible with a public telephone network (*e.g.*, telephone line 5541)," as claimed. Therefore, Applicants respectfully submit that the portion of claim 22 that recites Applicants' claim feature "identifying a second remote system accessible to the portable terminal device" **is** described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention, contrary to the assertion of the Office.

In addition, the portion of the Specification cited by the Office (*i.e.*, page 294, lines 3-13) relates to FIG. 59, which is “a block diagram illustrating the packet processing functionality of the access devices illustrated in Fig. 55a,” (*id.* at page 293, lines 7-9) and is in agreement with the portion of the specification discussed above, but from the point of view of an “access device” (e.g., “access device 5509”). It should be noted that the “call request packet,” referenced by the Office, is the “call route request packet “ discussed above.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that claim 22 is in compliance with 35 U.S.C. §112, first paragraph.

**With regard to independent claims 30 and 54**, Applicants respectfully submit that claims 30 and 54 recite similar language, were rejected for the same reason as claim 22, and that claims 30 and 54 are therefore in compliance with 35 U.S.C. §112, first paragraph, for at least the reasons set forth above.

**With regard to independent claim 78**, Applicants respectfully submit that claim 78 recites language similar to that of claims 22, 30, and 54, was rejected for the same reason as claim 22, and that claim 78 is therefore in compliance with 35 U.S.C. §112, first paragraph, for at least the reasons set forth above.

**With respect to dependent claims 23-29, 32-38, 55-59, 79-86, 93-95, 122, 124, 126, 128, and 134-149**, Applicants respectfully submit that those claims were rejected solely because they depend on rejected independent claims 22, 30, 54, and 78.

Based at least upon the above, Applicants respectfully submit that independent claims 22, 30, 54, and 78, and their respective dependent claims, are in compliance with 35 U.S.C. §112, first paragraph, and request that the rejection of claims 22-30, 32-38, 54-59, 78-86, 93-95, 122, 124, 126, 128, and 134-149 under 35 U.S.C. §112, first paragraph, be reconsidered and withdrawn.

**II. Claims 22-30, 32-38, 122, 124, And 134-141 Are In Compliance With 35 U.S.C. §112, Second Paragraph**

Claims 22-30, 32-38, 122, 124, and 134-141 stand rejected under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse the rejection.

**With regard to independent claims 22 and 30**, Applicants respectfully submit that the Office rejects claims 22 and 30 asserting, in part, at pages 5-6, the following:

- In reference to claim 22

Claim 22 is directed to a portable terminal device (i.e. an apparatus). The language in lines 13-25 "wherein the portable terminal device transmits... call connection with the subscriber" renders the claim indefinite because it is unclear which structural component (e.g. microphone converter, transmitter, receiver, transducer) of the portable terminal device each of the wherein clauses is attempting to define. The claim should be amended to so that the functional language in lines 13-25 clearly defines a component of the portable terminal device.

- In reference to claim 30

Claim 30 is directed to a portable terminal device (i.e. an apparatus). The language in lines 12-24 "wherein the portable terminal device transmits... call connection with the subscriber" renders the claim indefinite because it is unclear which structural component (e.g. microphone, converter, transmitter, receiver, transducer) of the portable terminal device each of the wherein clauses is attempting to define. The claim should be amended to so that the functional language in lines 13-24 clearly defines a component of the portable terminal device.

- In reference to claim 23-29, 32-38, 122, 124, 134-141

Claims 23-29, 32-38, 122, 124, and 134-141 are rejected because they depend on a rejected independent claim.

Applicants have amended claims 22 and 30 as shown above to address the concerns of the Office, and respectfully submit that, in regard to claim 22, the functional language previously recited by lines 13-25 has been amended as shown above to clearly define a component of the portable terminal device and that, in regard to claim 30, the functional language previously recited by lines 12-24 has been amended as shown above to clearly define a component of the portable terminal device, as required by the Office. Applicants respectfully submit that by these amendments, the concerns of the Office have been addressed without adding new matter, and that claims 22 and 30 are in compliance with 35 U.S.C. §112, second paragraph. Further, because claims 23-29, 32-38, 122, 124, and 134-141 were rejected simply because they depended from rejected independent claims 22 and 30, Applicants respectfully submit that those claims are also in compliance with 35 U.S.C. § 112, second paragraph.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that claims 22-30, 32-38, 122, 124, and 134-141 are in compliance with 35 U.S.C. §112, second paragraph, and respectfully request that the rejection of those claims under 35 U.S.C. 112, second paragraph, be reconsidered and withdrawn.

### **III. Claims 22-34, 36-38, 54-59, 78-86, 93-122, 124, 126, 128, and 130-149 Are Allowable Over The Prior Art**

Applicants respectfully submit that the Office has not asserted that claims 22-34, 36-38, 54-59, 78-86, 93-122, 124, 126, 128, and 130-149 are either anticipated or otherwise rendered unpatentable over any prior art under any subsection of either 35 U.S.C. §102 or 35 U.S.C. §103. Therefore, for at least the reasons set forth above, Applicants respectfully submit that the pending claims are allowable.



### **Telephone Interview**

Applicants' Representative Kevin E. Borg expresses appreciation to Examiner Brian S. Roberts for the opportunity to discuss the rejections of claims 22 and 30 in the instant Office action, during a telephone call of May 11, 2011. No agreements were reached.

### **Conclusion**

In general, the Office action has made various statements regarding the claims and the cited references during the course of prosecution that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 22-34, 36-38, 54-59, 78-86, 93-95, 122, 124, 126, 128, and 134-149 are in condition for allowance. Therefore, allowance of those claims is respectfully requested.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000 to resolve any issues.

Respectfully submitted,

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